UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,952	09/26/2001	Toshihide Hida	1122.65856	1582

7590	04/06/2006		

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EXAMINER
KRISCIUNAS, LINDA MARY

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr>
<td rowspan="2" style="vertical-align:middle;">Office Action Summary</td>
<td>Application No.</td>
<td>Applicant(s)</td>
</tr>
<tr>
<td>09/963,952</td>
<td>HIDA, TOSHIHIDE</td>
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<td></td>
<td>Examiner</td>
<td>Art Unit</td>
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<td>Linda Krisciunas</td>
<td>3623</td>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 March 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>7-24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>7-24</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This is a Final Office Action in response to the amendments filed March 3, 2006.

Claims 1-6 were canceled and claims 7-24 were amended with claims 7-24 pending.

The Examiner's last name has changed from Morawski to Krisciunas.

Response to Amendment

2.   The Applicant has amended claims 7-24.

Response to Arguments

The Examiner has fully considered the applicant's arguments with respect to the

Bilbrey (US 2002/0103932) reference and it is deemed not persuasive. Bilbrey teaches

sending the absence response information to the server and updating the appropriate

databases based upon where the request originated from as noted in paragraph 55:

"the system 100 also utilizes the RM 104 to perform routine checks of e-mail address

lists against new "active" COA data at the Network Server 106. The RM 104

communicates with the Network Server 106 in order to request and receive new e-mail

addresses and other information relating to e-mail subscriptions. The RM 104 may

also be configured to retrieve any new COA records from the Sponsor DB 102 and

update the Network Server 106 with such information." See also Figure 17A and Figure

27.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 7-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Bilbrey

et al (US 2002/0103932)

As per claims 7, 13 and 19, Bilbrey teaches a computer readable medium that

stores a program to cause a computer to perform message address management

(paragraph 83: Reconnection Manager (104) which provides updates of recipient

mailboxes/addresses): when a message address of a member of a message group

exchanging is changed absence response information including at least an old address

and a new address of the member is caused to be received from the client (See Figure

21: "FIG. 21 is an illustrated flow diagram depicting a modification of the process

shown in FIG. 20 where, in addition to specifying an old address and a new address on

a Sponsor's web site, the recipient also specifies whether such address information is

to be shared with the Network Server and with other Sponsors for another embodiment

of the present invention."); determining from a plurality of provided message address

lists a message address list including the old address of the member and extracting

message addresses of the rest of the members of the determined message address

list (paragraph 58: "FIG. 1 illustrates one process by which this function may be

implemented. As shown, the process begins when a user of the RM 104 requests an

updating of e-mail address listings from the Sponsor DB 102 (Step 1). At this point, the

process communicates the address list to the RM 104 which is then suitably updated

with the Sponsor's e-mail address list (Step 2). Upon receiving the request, the RM

104 requests the updated e-mail address list from the Network Server 106 (Step 3).

The Network Server encrypts and sends back to the RM 104 COA changes since the

last update request from the RM 104 (Step 4). The e-mail addresses received from the

Network Server 106 are then matched to old e-mail addresses provided by the

Sponsor DB 102 to the RM 104 (Step 5). The RM 104 also, preferably, is capable of

reading e-mail addresses directly from the Sponsor's DB 102 in order to perform a

match if desired. Once these matches have been made, the RM 104 suitably

communicates those listings identified by the matching process to the Network Server

106 (Step 6)." Where the other addresses would require extracting if the list is to be

updated and sent back in its updated format.); specifying a server to which the

absence response information is to be provided, on the basis of the extracted message

address; and distributing the absence response information to the specified server

(paragraph 59, where the network server (106) communicates with the RM (104) which

then communicates with the Sponsor database (102) to provide the new information).

As per claims 8, 14 and 20, Bilbrey teaches the absence response information

contains information regarding a period of validity of the absence response information

(paragraph 112 and Table 3 where a determination is made as to whether the

addresses are active. If they are active the change of address information is made

available to the Sponsors. See also paragraph 68: "time-stamped").

As per claims 9, 15 and 21, Bilbrey teaches a plurality of pieces of the absence

response information to be distributed to the same server are gathered together for

distribution (paragraph 58: "FIG. 1 illustrates one process by which this function may be

implemented. As shown, the process begins when a user of the RM 104 requests an

updating of e-mail address listings from the Sponsor DB 102 (Step 1). At this point, the

process communicates the address list to the RM 104 which is then suitably updated

with the Sponsor's e-mail address list (Step 2). Upon receiving the request, the RM 104

requests the updated e-mail address list from the Network Server 106 (Step 3)", where

a list would constitute multiple pieces of information).

As per claims 10, 16 and 22, Bilbrey teaches receiving from a server absence

response information including at least an old address and a new address of a member

of a message exchanging group (See Figure 21: "FIG. 21 is an illustrated flow diagram

depicting a modification of the process shown in FIG. 20 where, in addition to

specifying an old address and a new address on a Sponsor's web site, the recipient

also specifies whether such address information is to be shared with the Network

Server and with other Sponsors for another embodiment of the present invention.");

when receiving a message to be transmitted to another server, judging whether or not

an original address of the received message matches the old address contained in the

absence response information (paragraph 58: "The e-mail addresses received from the

Network Server 106 are then matched to old e-mail addresses provided by the

Sponsor DB 102 to the RM 104 (Step 5). The RM 104 also, preferably, is capable of

reading e-mail addresses directly from the Sponsor's DB 102 in order to perform a

match if desired. Once these matches have been made, the RM 104 suitably

communicates those listings identified by the matching process to the Network Server

106 (Step 6)."); replacing the original address of the message with a new address

associated with the old address matching the original address (paragraphs 49-51,

where the address lists are updated, which encompasses replacing the old address

with the new address); and transmitting the message using the replaced address,

which is the new address in the absence response information (See Figure 20 where

the user receives the e-mail at the new address).

As per claims 11, 17 and 23, Bilbrey teaches when the message has been

transmitted to the new address, notifying an administrator of the message exchange

system or a requestor of the message transmission that the message has been

transferred to the new address (paragraph 93, where the recipient with the new address

can specify who is notified of the new address. This guarantees that these addresses

will be able to send messages to the new address.)

As per claims 12, 18 and 24, Bilbrey teaches a message address of a member of

a message exchanging group is changed, creating absence response information

including at least an old address and a new address corresponding to the message

address (See Figure 21: "FIG. 21 is an illustrated flow diagram depicting a modification

of the process shown in FIG. 20 where, in addition to specifying an old address and a

new address on a Sponsor's web site, the recipient also specifies whether such address

information is to be shared with the Network Server and with other Sponsors for another

embodiment of the present invention."); and transmitting the absence response

information to the server which transmits a message from the client (paragraph 59,

where the network server (106) communicates with the RM (104) which then

communicates with the Sponsor database (102) to provide the new information).

Conclusion

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

6.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Linda Krisciunas whose telephone number is 571-272-

6931. The examiner can normally be reached on Monday through Friday, 6:30 am to

3:00 pm.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

LMK

March 24, 2006

SUSANNA M. DIAZ
PRIMARY EXAMINER

AU 3623